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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/068,713	02/06/2002	Tadayoshi Takahashi	10059-407US (P25715-02)	1638
570	7590	04/06/2006	EXAMINER	
AKIN GUMP STRAUSS HAUER & FELD L.L.P. ONE COMMERCE SQUARE 2005 MARKET STREET, SUITE 2200 PHILADELPHIA, PA 19103			MERCADO, JULIAN A	
			ART UNIT	PAPER NUMBER
			1745	

DATE MAILED: 04/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/068,713	Applicant(s) TAKAHASHI ET AL.	
	Examiner Julian Mercado	Art Unit 1745	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 13 February 2006.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-8 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1, 3 and 5 is/are rejected.

7) ☒ Claim(s) 2, 4 and 6-8 is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____

4) ☐ Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____

DETAILED ACTION

Remarks

This Office action is responsive to applicant's response after Final filed February 13, 2006.

Applicant's amendment has been entered. A new ground of rejection is set forth below. This Office action is therefore made NON-FINAL.

Claims 1-8 are presently pending.

Information Disclosure Statement

The non-patent document "Kyouritsu SHUPPAN" cited in the February 6, 2002 Information Disclosure Statement has not been considered by the examiner for the reasons of record. Applicant's arguments have been fully considered but are not found persuasive. Applicant appears to rely on the international search report as a statement of relevance. In reply, the examiner maintains that this reference cannot be given its full consideration as it is in a non-English language. 37 C.F.R. 1.98 specifically outlines the requirement for "[A] concise explanation of the relevance, as it is presently understood by the individual designated in § 1.56(c) most knowledgeable about the content of the information, of each patent, publication, or other information listed that is not in the English language." It appears to the examiner that applicant is incorporating the international search report by reference as a statement of relevance. If so, it is the examiner's position that the search report offers little towards an *explanation* of the relevance of the document. Notwithstanding, does applicant really want the examiner to

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consider a reference which, with exception to a few chemical compound names, is largely written in a non-English language?

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the instant “major inner face” and “major outer face” must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102 and 103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3 and 5 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Horie et al. (U.S. Pat. 6,146,789).

The rejection is maintained for the reasons of record. At the outset, the examiner acknowledges the agreement that was made on January 20, 2006, whereby the proposed amendment (now entered) appeared to the examiner as overcoming the rejection based on Horie et al. Upon further review and even with the amended claim language, the examiner maintains that the teachings of Horie et al. are still readable on the claims for detailed reasons not yet discussed. In order to give applicant the opportunity of a reply, this Office action is made Non-Final.

The detailed reasons in maintaining the ground of rejection based on Horie et al. are as follows: The claims now require, *inter alia*, a major inner face of the metal case and a major

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outer face of a sealing body. The examiner notes that these terms are not part of applicant's original disclosure, though it appears to the examiner that these features correspond to portions of the drawings such as seen in Figure 2. (note: the instant features correspond to the objections to the drawings set forth above) To this extent, the major inner face appears to be along the inner face of the metal case [20] while the major outer face appears to correspond to the outer face of sealing body [16]. It is noted, however, that the major outer face is nothing more than the *edge portion* of the sealing body. Thus, Horie et al. is considered to similarly teach a major inner face of the metal case [21], i.e. the edge portion thereof, and a major outer face of the sealing body [22]. The major outer face of the sealing body in Horie et al. is not unlike the major inner face now claimed insofar as the disclosed outer face and the claimed inner face are each along the *planar portion* of the metal sheet.

As to a chemical affinity of the organic pigment and as to its even dispersion, it is maintained that the dye disclosed by Horie et al. inherently has an elastomeric affinity and is evenly dispersed, absent of a showing by applicant that the claimed invention distinguishes over the reference. *In re Best*, 195 USPQ at 433, footnote 4 (CCPA 1977) and *In re Spada*, 15 USPQ 2d 1655 (Fed. Cir. 1990) See Horie et al. in col. 5 line 8 et seq.

Allowable Subject Matter

Claims 2, 4 and 6-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The reasons for provisional allowance of claims 2, 4 and 6-8 are maintained for the reasons of record.

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The examiner acknowledges applicant's request for the reasons of allowance of claim 5. Applicant is correct that the reasons of allowance set forth for claims 2, 4, and 6-8 are not commensurate with the scope of claim 5. To this extent, the provisional allowance of claim 5 is rescinded. Claim 5, which is a dependent claim, is presently rejected in this Office action.

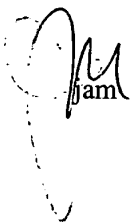
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian Mercado whose telephone number is (571) 272-1289. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick J. Ryan, can be reached on (571) 272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

A handwritten signature in dark ink, appearing to be 'J. Mercado', with the letters 'jam' written in smaller text below it.